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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/476,686

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GEOFFREY B. RHOADS

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23735

7590

09/21/2006

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
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EXAMINER

SONG, HOSUK

ART UNIT

PAPER NUMBER

2135

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/476,686	Applicant(s) RHOADS ET AL.	
	Examiner HOSUK SONG	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8, 11-18 and 25-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-43 is/are allowed.
- 6) ☒ Claim(s) 5, 6, 11-16, 25, 26 and 44-50 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09476686</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 5-6,11-16,25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Min-Jae(US 6,222,807).

Claims 5,15: Min-Jae discloses receiving audio at a device in (fig.1). Min-Jae discloses discerning from the audio a plural-bit audio ID in (col.20,lines 23-37). Min-Jae discloses obtaining a user ID from a memory in the device in (col.23,lines 19-30). Min-Jae disclose transmitting at least portions of both the audio ID and the user ID to a location remote from the device in (col.12,lines 54-66).

Claims 6,16: Min-Jae discloses audio ID comprises Digital Object Identifier in (fig.7 and col.20,lines 23-36).

Claim 25: Min-Jae disclose responsive to transmission,receiving data from the remote location, the received data relating to audio and presenting at least some of the received audio on a display in (col.13,lines 28-44).

Claim 26: Min-Jae discloses received data includes data representing a song title, and the method includes presenting song title on the display in (fig.7).

Claim 11: Min-Jae discloses transducer to receive ambient audio and to output electrical signals corresponding thereto to the input of a processing system operable to detect an identifier of the ambient audio from the electrical signals in (fig.1 and col.20,lines 23-37). Min-Jae disclose a memory storing user identification information and an interface coupled to an output of the processing system for receiving the

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identifier and coupled to the memory for receiving at least some of the user identification for transmission to a relay station in (col.12,lines 54-66).

Claim 12: Min-Jae discloses interface is a wireless interface in (col.12,lines 49-53).

Claim 13: Min-Jae discloses alphanumeric display in (col.13,lines 33-35).

Claim 14: Min-jae discloses keypad in (fig.3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 44-50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Min-Jae(US 6,222,807).

Claim 44: Min-Jae does not specifically disclose the identifier is extracted from a digital watermark embedded in the electrical signals corresponding to the ambient audio. It would have been obvious to person of ordinary skill in the art to modify the invention of Min-Jae to employ digital watermark in order to deter and data modification and protect the ownership of its content.

Claim 45: Min-Jae discloses the interface is a wireless interface in (col.12,lines 49-53).

Claim 46: Min-Jae discloses alphanumeric display in (col.13,lines 33-35).

Claims 47-48: Min-Jae discloses keypad in (fig.3).

Claim 49: Min-Jae discloses received data includes data representing a song title, wherein the device permits identification of a song sensed by the transducer in (col.12,lines 54-67).

Claim 50: Min-Jae discloses identifier comprises a Digital Object Identifier in (fig.7 and col.20,lines 23-36).

Allowable Subject Matter

4. Claims 7-8,17-18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 27-43 are allowed.

Response to Applicant's Arguments

5. Applicant has argued that Min-Jae's patent does not disclose discerning from the audio a plural-bit audio ID and that the control information relied upon in Min-Jae is stored in a control file and while the control information may include pieces of file information, "each piece is recorded for an audio file in a group of files and the control information does not seem to be discerned from the audio; rather it is created for audio. In response: the Examiner strongly disagrees with applicant's contention that a plural bit audio ID is not discerned from audio. Min-Jae's patent is directed to controlling/processing an audio file such as editing,copying and playback. The control file includes a song ID, pieces of file information each recorded for an audio file in the group of files where each piece of file information comprises various kinds of other information such as the type of the audio file, an address pointer indicating the recording location of the audio file on the HDD. To be more specific, an audio or piece of music data is transmitted by the information center to the recording playback apparatus to be stored therein as a file (col.8,lines 4-6). Recording playback device reads control information file related to one or a plurality of audio files associated with control file and related to the associated relevant information file. Meaning, in order for system to process the audio file, it must first locate the audio file (reads ID audio file from the HDD) and read control file in order to process the audio file. The examiner agree with applicant that

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control information is created for audio but strongly disagree that audio ID is not discerned from audio because in order to process the audio file, audio ID is discerned from the audio as well as from the control information file (see col.19,lines 57-67;col.20,lines 1-9,34-23-57). Further, since audio file is received and stored in the device, there must be an identification representing audio file in order for device to locate, read and process the audio file using control information file. Applicant has argued that Min-Jae does not disclose an audio ID decoded from audio. In response: Examiner disagrees. Fig.3,#29 disclose a decoder for decoding audio data and ID.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

USPTO Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOSUK SONG whose telephone number is 5712723857. The examiner can normally be reached on mon-fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM VU can be reached on 5712723859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HOSUK SONG
PRIMARY EXAMINER